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21

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Paper No.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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In re Industrial Business Services, Inc.  
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Serial No. 75/215,495  
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Daniel S. Polley for Industrial Building Services, Inc.

Michael L. Engel, Trademark Examining Attorney, Law  
Office 108 (David Shallent, Managing Attorney).  
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Before Hanak, Hohein and Hairston, Administrative  
Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Industrial Building Services, Inc. of Fort  
Lauderdale, Florida (applicant) seeks to register on the  
Supplemental Register INDUSTRIAL BUILDING SERVICES for  
"plumbing services; electrical contracting; installation,  
repair and maintenance of air conditioning apparatuses,  
heating apparatuses, refrigeration apparatuses,  
ventilating apparatuses, electrical apparatuses and air  
conditioning apparatuses; general contracting services  
for construction and building renovation; installation,  
maintenance and repair of automation systems, namely,

heating, air conditioning, ventilating, electrical, and refrigeration."

Ser. No. 75/215,495

The Examining Attorney has refused registration on the basis that INDUSTRIAL BUILDING SERVICES is a generic term for applicant's services, and thus pursuant to Section 23 of the Trademark Act is incapable of distinguishing applicant's services.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

Before proceeding to determine whether INDUSTRIAL BUILDING SERVICES is a generic term for applicant's services, it is helpful to review the history of this application. The application was initially filed with the PTO on December 19, 1996 as an intent-to-use application seeking registration of INDUSTRIAL BUILDING SERVICES on the Principal Register. The Examining Attorney initially refused registration pursuant to Section 2(e)(1) of the Trademark Act on the basis that applicant's mark was merely descriptive of applicant's services. In response to the first Office Action,

applicant argued that its mark was not merely descriptive of its services. In addition, applicant voluntarily disclaimed the exclusive right to use the word SERVICES. In the second Office Action, the Examining

2

Ser. No. 75/215,495

Attorney maintained the refusal on the basis that applicant's mark was merely descriptive of its services. Thereafter, applicant filed an amendment to allege use with a first use date of January 1994 and an amendment to seek registration on the Supplemental Register as opposed to the Principal Register. In the third and fourth Office Actions, the Examining Attorney refused registration on the basis that applicant's mark was a generic term for applicant's services. Thereafter, applicant appealed to this Board.

We note at the outset that "the burden of showing that a proposed trademark [or service mark] is generic remains with the Patent and Trademark Office." In re Merrill Lynch, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). Moreover, it is incumbent upon the Examining Attorney to make a "substantial showing ... that the matter is in fact generic." Merrill Lynch, 4 USPQ2d at

1143. Indeed, this substantial showing "must be based on clear evidence of generic use." Merrill Lynch, 4 USPQ2d at 1143. Thus, "a strong showing is required when the Office seeks to establish that a term is generic." In re K-T Zoe Furniture Inc., 16 F.3d 390, 29 USPQ2d 1787, 1788 (Fed. Cir. 1994). Moreover, any doubt whatsoever on the issue of genericness

Ser. No. 75/215,495

must be resolved in favor of the applicant. In re Waverly Inc., 27 USPQ2d 1620, 1624 (TTAB 1993).

Obviously, applicant's mark INDUSTRIAL BUILDING SERVICES consists of a three word phrase. Our primary reviewing Court has made it clear that the PTO "cannot simply cite definitions and generic uses of the constituent terms of a [phrase] mark ... in lieu of conducting an inquiry into the meaning of the disputed phrase as a whole to hold a mark ... generic." In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

In his three page brief, the Examining Attorney (who was not the original Examining Attorney) acknowledges that the only evidence in the record showing the generic

use of the entire phrase "industrial building services" are two newspaper articles which the original Examining Attorney attached to Office Action No. 2 dated June 9, 1998. The first article is from the July 30, 1996 edition of the News & Record of Greensboro, North Carolina. This article reads as follows: "Sunstates Maintenance Corp., a commercial housekeeping and janitorial company based in Greensboro, has acquired Seacrest Services of West Palm Beach, Florida.

4

Ser. No. 75/215,495

Terms were not disclosed. Seacrest is a janitorial maintenance company serving South Florida. Its 600 employees bring Sunstates' total payroll to 2,000. Founded in 1975, Sunstates focuses primarily on the commercial, corporate and industrial building services market." (emphasis added). The second article is from the June 1, 1992 edition of The Washington Post. The headline of this article reads as follows: "Maryland Food Stores to Charge Tax." The vast majority of this article discusses how Maryland grocery stores will start charging sales tax for a variety of snacks, deli sandwiches and salad bar items. However, the final sentence of this

article reads as follows: "Starting July 1, commercial and industrial building services also will become taxable." (emphasis added). The original Examining Attorney also attached a third article to this second Office Action. However, this third article supports applicant's position that its mark INDUSTRIAL BUILDING SERVICES is capable of functioning as a trademark. This third article is from the January 16, 1995 edition of the Sun-Sentinel of Fort Lauderdale, applicant's primary place of business. This article clearly refers to applicant as a \$7 million company with nine locations

Ser. No. 75/215,495

throughout Florida. The article then concludes with the following sentence: "The business has expanded into Industrial Building Services, which incorporates air conditioning, plumbing, general contracting, electrical and building automation." (emphasis added).

In response to the first two articles, applicant makes two points. First, applicant states that as demonstrated by the article from the News & Record of Greensboro, North Carolina, if the term "industrial building services" is generic for any type of services,

it is generic for "housekeeping and janitorial services." (Applicant's Reply Brief page 2). Second, as for the article from The Washington Post, applicant simply notes that it is impossible to tell from this article what services the term "industrial building services" is referring to. (Applicant's Reply Brief page 2).

We agree with applicant on both points. To elaborate, the article from the News & Record in no way supports the notion that applicant's mark INDUSTRIAL BUILDING SERVICES is a generic term for applicant's plumbing services, electrical contracting services, air conditioning services and the like. At the very most, this article tends to demonstrate

Ser. No. 75/215,495

that the term "industrial building services" may be a generic term for commercial janitorial services. We also agree with applicant that the appearance of the term "industrial building services" in The Washington Post article sheds absolutely no light on what these services might be. Thus, this article is of no probative value in showing that applicant's mark INDUSTRIAL BUILDING SERVICES is a generic term for the services set forth in

applicant's application.

In short, based upon the present record, we find that the PTO has simply failed to make the required "substantial showing" or "strong showing" that the phrase INDUSTRIAL BUILDING SERVICES is generic for applicant's services. Merrill Lynch, 4 USPQ2d at 1143 and K-T Zoe Furniture, 29 USPQ2d at 1788. At an absolute minimum, there exist doubts on the issue of genericness, and accordingly, we must resolve such doubts in favor of the applicant. Waverly, 27 USPQ2d at 1624.

Decision: The refusal to register is reversed.